

REMARKS

The specification has been amended for better form. Claim 12 has been amended in a non-limiting manner to further clarify how multiple slides are stacked. New claims 21-33 are added. Claims 12-33 are pending in the application. The amendments and new claims do not present new matter and are supported by the application as filed. See, e.g.,

p. 8, lines 19-23 (regarding claim 1) (offset refers to edges of adjacent slides not overlapping or not being aligned with each other);

Fig. 5A (regarding claims 21 and 22) (angle of one support member surface that contacts a slide is greater than 90 degrees relative to horizontal, and angle of one support member surface that contacts a slide is less than less than 90 degrees relative to the horizontal);

p. 15, lines 1-18; Figs. 5A-B (regarding claim 23) (gap between slides);

Fig. 5A (regarding claim 24) no slide lies flatly upon another slide);

p. 15, lines 1-10; Figs. 5A-B (higher slide arranged at a steeper angle);

p. 15, line 12, Fig. 5A (claim 26) (angled gaps);

p. 15, line 13, Fig. 5A (claim 27) (generally triangular gaps);

Figs 5A-B and 6A-B (claim 28) (a first support member extends upwardly from base, and a second support member extends downwardly towards the base, a slot is defined between the base and the bottom of the second support member);

Figs. 5A-B (claim 29) (second support member supports each slide except the bottom slide, which is dispensed through the slot);

p. 8, lines 24-27, p. 15, lines 1-10; Figs. 5A-B (claim 30) (each slide is stacked at a different angle);

p. 2, line 11 - p. 3, line 19; p. 17, lines 6-15; Figs. 5A-B; (claim 31) (only bottom slide dispensed through slot); and

Figs. 5A-B (claims 32 and 33) (first and second angles are angles other than 90 degrees relative to the horizontal and one angle is acute and the other angle is obtuse).

Reconsideration of the application, as amended, is respectfully requested.

I. Claims 12-15 and 18-20 Are Patentable Over Weaver

Independent claim 12 and dependent claims 13-15 and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,010,468 to Weaver (“Weaver”). The Office action asserts that Weaver discloses all of the elements of claim 12, and that it would have been obvious to use the apparatus described in Weaver to dispense slides rather than labels. Applicants respectfully traverse the rejection.

Initially, the Office action has not established a *prima facie* case that claim 12 is unpatentable over Weaver since the Office action does not address the “angularly stacked” limitation of claim. 35 U.S.C. § 132 states, “Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application...” 37 C.F.R. § 104(c)(2) states “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command ... The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” The Office action, however, disregards the “angularly stacked” limitation of claim 12, contrary to the requirement that all words in a claim be considered when assessing patentability. MPEP §2143.03. Nevertheless, Weaver cannot support a rejection under §103(a).

Under 35 U.S.C. §103(a), to establish a *prima facie* case of obviousness of a claim, all of the claim limitations must be taught or suggested, and all words in a claim must be considered in judging the patentability of that claim against Weaver. MPEP §§2143; 2143.03, citing *In re Royka*, 490 F.2d 981 (CCPA 1974). In addition, there must be some suggestion or motivation to modify Weaver, and a reasonable expectation of success. MPEP §§2143.01-2143.03, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The mere fact that Weaver can be modified does not render the resultant modification obvious unless the reference also suggests the desirability of the modification. MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990.) Further, if a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.) MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984.) It is also improper to modify or combine references where the references teach away from the modification or combination. MPEP §2146, citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983.) See also *In re Haruan*,

249 F.3d 1327 (Fed. Cir. 2001) (“A prima facie case of obviousness can be rebutted if the applicant . . . can show ‘that the art in any material respect taught away’ from the claimed invention.”) Applicants respectfully submit that Weaver cannot support the rejection in view of the requirements.

Initially, Weaver fails to disclose or suggest “the plurality of slides being angularly stacked relative to the horizontal on the base member.” Instead, Weaver describes and illustrates flat labels that are stacked on top of each other in a flat, linear manner. Specifically, Weaver explains that containers are constructed so that labels “lie flat.” (Weaver, col. 1, lines 25-26) (emphasis added). This is clearly illustrated in Figure 2 of Weaver. In other words, labels are parallel to each other and to the horizontal and, therefore, are not angularly stacked relative to the horizontal. The arrangement of the bottom six slides illustrated in Figure 2 of weaver is not “angularly stacked” as recited in claim 1 since claim 1 also recites “at least the two bottom slides of the plurality of slides are offset so that edges of adjacent slides do not overlap each other. Consequently, Weaver, at best, discloses one of these limitations, but clearly does not disclose or suggest both limitations.

In addition, Applicants respectfully submit Weaver is not suitable for storing slides. Rather, Weaver states that the patent is used for “Holding Labels or the Like...” (Weaver, col. 1, line 7). Slides are not labels and are not “like” labels. Labels are typically bendable and flexible, whereas slides are made of different materials and substantially rigid.

There is also no suggestion or motivation to modify Weaver according to claim 12. The required suggestion or motivation is simply lacking, and Weaver does not suggest why such substantial modifications would be desirable. This conclusion is consistent with Figure 2 and col. 1, lines 25-26 of Weaver, which illustrate and describe labels that lie flat and that are stacked on top of each other parallel to each other and a horizontal.

Further, considering that it is well known that labels are flexible, they cannot be angularly stacked since stacking labels in this manner would cause the labels to fold or bend, causing the labels to be bent or damaged. Consequently, the apparatus described in Weaver would be rendered inoperable for its intended purpose, and the required suggestion or motivation to modify Weaver is lacking. MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Correspondingly, claim 12 is patentable over Weaver. Dependent claims 13-15 and 18-20 incorporate all of the elements and limitations of claim 12 and add novel and non-obvious

limitations thereto. Thus, dependent claims 13-15 and 18-20 are patentable over Weaver for the reasons set forth above. MPEP §2143.01, citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Further, Applicants respectfully disagree with the Office action assertion that it would have been obvious to add a friction reducing member that contacts one or more slides as recited in claim 20. Adding such components would unnecessarily complicate a label dispenser. Moreover, Weaver suggests the opposite result, i.e., adding friction rather than reducing friction. Specifically, Weaver explains “If desired, a weight 28 may be placed upon the upper most label 26 to force the same downwardly, as some of them are being drawn out of the shell through the opening.” (Weaver, col. 2, lines 94-98). Thus, the Office action assertion regarding a friction reducing member contradicts Weaver’s clear and unambiguous statement that weight can be added, which would increase friction. Thus Weaver teaches away from claim 20, which recites an element that achieves the opposite effect of that described in Weaver. MPEP §2146 (it is improper modify a reference or combine references where the references teaches away), citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). See also *In re Haruan*, 249 F.3d 1327 (Fed. Cir. 2001) (prima facie case of obviousness rebutted if art teaches away from claimed invention in any material respect.)

In view of the above remarks, Applicants respectfully request that the rejection of claims 12-15 and 18-20 under 35 U.S.C. §103(a) be withdrawn.

II. Claims 16 and 17 Are Patentable Over Weaver and Goodman

Dependent claims 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of U.S. Patent No. 2,854,169 to Goodman (“Goodman”). Claims 16 and 17 incorporate all of the elements and limitation of claim 12 and novel and non-obvious limitations thereto. Thus, dependent claims are patentable for the reasons set forth above. MPEP §2143.03 (if an independent claim is non-obvious, then a claim that depends from the independent claim is also non-obvious), citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

The Office action relies on Goodman solely as assertedly disclosing flexible first and second support members. In particular, the Office action refers to follower 38, which swings behind egg cartons as they are moved along a sloped platform 19. (Goodman, Fig. 2). Goodman, however, does not cure the deficiencies of Weaver. Consequently, assuming *arguendo* that the asserted combination were made, the references would nevertheless fail to

disclose or suggest every limitation of claims 12, 16 and 17 and, therefore, cannot support a rejection under 35 U.S.C. §103(a). MPEP §2143.03.

Additionally, there is no suggestion or motivation to combine Weaver and Goodman. Weaver is directed to a case for holding “labels and the like.” (Weaver, col. 1, line 7). Goodman, on the other hand, is directed to a dispenser for relatively fragile cartons, in particular, egg cartons. (Goodman, col. 1, lines 15-27; col. 2, line 47). A label is flat and can be stacked flat, whereas egg cartons are irregularly shaped and designed so that fragile eggs do not break. Further, Goodman only describes a configuration in which the platform is sloped and, therefore, not substantially parallel to the horizontal. Thus, the required suggestion or motivation to combine the references is clearly lacking in view of the different arts and substantially different structures described in the references. Arranging egg cartons as recited in claim 12 would also necessarily complicate the device to such a degree that it would not be operable for its intended purpose since the egg cartons would not be aligned as shown in Figure 2 of Goodman. Therefore, the required suggestion or motivation to combine the references is lacking. MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). In view of the above remarks, Applicants respectfully request that the rejection of claims 16 and 17 under 35 U.S.C. §103(a) be withdrawn.

III. New Dependent Claims 21-33 Are Patentable Over the Cited References

New dependent claims 21-33 incorporate all of the elements and limitations of independent claim 12 and add novel and non-obvious limitations thereto. Thus, dependent claims 21-33 are patentable over the cited references for the reasons set forth above. MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Applicants submit the following additional remarks to demonstrate that Weaver cannot support any rejection of various dependent claims.

Weaver fails to disclose or suggest “wherein the second angle is an angle of a surface of the second support member that contacts the slides, and the second angle is less than 90 degrees relative to the horizontal” as recited in claim 22. Rather, Weaver describes a shell wall that stands upright (90 degrees).

Weaver fails to disclose or suggest “wherein a gap exists between each slide in the angularly stacked plurality of slides” as recited in claim 23. No such gap is described or illustrated.

Weaver fails to disclose or suggest “wherein no slide lies flatly upon another slide in the angularly stacked plurality of slides” as recited in claim 24. No such stacking arrangement is disclosed or suggested. Further, Weaver teaches away from claim 24 since Weaver explains that a container is “so constructed that the labels may be introduced therein to lie flat...”(Weaver, col. 1, lines 25-26).

Weaver also fails to disclose or suggest “wherein a higher slide in the plurality of slides is arranged at an angle that is steeper than the angle at which a lower slide in the plurality of slides is arranged” as recited in claim 25. Rather, as discussed above, Weaver describes labels that are stacked on top of each other and lie flat.

Further, Weaver fails to disclose or suggest “wherein the fanning arrangement results in a series of angled gaps defined by one of the support members and adjacent slides” as recited in claim 26 and “wherein the fanning arrangement results in a series of generally triangular gaps defined by one of the support members and adjacent slides.” No such angled or generally triangular gaps are disclosed by Weaver.

Weaver also fails to disclose or suggest “wherein the first support member extends upwardly from the base, and the second support member extends downwardly towards the base, wherein the slot is defined between the base and the bottom of the second support member” as recited in claim 27. Rather, as shown in Figure 2 of Weaver, the base does not extend across the width of the shell, and the right wall does not extend downwardly toward the base. Further, a slot is not defined the second support member and the base since the base width is reduced.

Moreover, Weaver fails to disclose or suggest “wherein the second support member supports each slide of the plurality of slides except the bottom slide, wherein the bottom slide is dispensed through the slot” as recited in claim 29. Instead, Figure 2 of Weaver illustrates at least six labels being dispensed through the slot. There is no structure or mechanism to ensure that only a single label is dispensed. This is contrary to the subject application, which describes improving slide picking accuracy and selecting individual slides. (p. 2, lines 9-22).

Weaver also fails to disclose or suggest “wherein each slide is stacked at a different angle” as recited in claim 30. To the contrary, Weaver describes labels that are all stacked flat and all stacked parallel to each other.

Further, Weaver fails to disclose or suggest “wherein only the bottom slide of the plurality of slides is dispensed through the slot” as recited in claim 31. Instead, Weaver shows multiple labels dispensed through a slot.

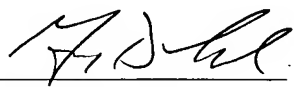
Weaver also fails to disclose or suggest “wherein the first and second angles are angles other than 90 degrees relative to the horizontal” as recited in claim 32 and “wherein the first angle is greater than 90 degrees and the second angle is less than 90 degrees” as recited in claim 33. No such angular configurations of first and second members are disclosed or suggested by Weaver. Instead, Weaver illustrates one of the shell walls being a vertical wall (90 degrees to a horizontal).

IV. Conclusion

Applicants respectfully request that application is in condition for allowance. Applicants reserve their right to file a divisional application with one or more of the claims that have been canceled in response to the restriction requirement. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

Respectfully submitted,

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